

REMARKS/ARGUMENTS

Claims 42 – 54 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks.

In the outstanding Office Action, the Examiner rejected claims 42 – 44 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 2, and 4 of U.S. Patent No. 6,475,162 to Hu (hereinafter referred to as “Hu”), and rejected claims 42 – 54 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,474,081 to Livingstone et al. (hereinafter referred to as “Livingstone”).

By this Response and Amendment, claim 42 is amended, and the rejections under nonstatutory obviousness-type double patenting and under 35 U.S.C. 102 are traversed. It is respectfully submitted that the above amendments do not introduce any new matter to this application within the meaning of 35 U.S.C. 132. Support for the amendments may be found in the specification including, *inter alia*, in the first paragraph of the “Summary of the Invention,” where it states that “Data outside of predetermined ranges of values is considered faulty data. Specifically, the measured data is compared to...certain ranges to determine if the measured data is outside of expected limits, thus indicating unreliable data results.”

DOUBLE PATENTING REJECTION

In the Outstanding Office Action, the Examiner rejected claims 42 – 44 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 4 of Hu. The Examiner states that “[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are merely an exact and even broader recitation of the claimed pending subject matter.”

RESPONSE

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046,29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887,225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937,214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A double patenting rejection must rely on a comparison with the claims in an issued (or to be issued) patent. *In re Bowers*, 359 F.2d 886,149 USPQ 570 (CCPA 1966).

By this Response, Applicants traverse the rejection under nonstatutory obviousness-type double patenting, as the claims of Hu fail to disclose, teach, or suggest all of the claimed features of the presently claimed inventive subject matter as amended, and are drawn to a patentably distinct invention

The presently claimed inventive subject matter as amended recites “a system for performing a medical examination comprising,” *inter alia*, “means connected to...measuring means for analyzing...data and for *comparing said data to predetermined values to determine if said data is outside of predetermined ranges and thus indicates unreliable data results.*” (Present Application, claim 42, emphasis added).

Hu claims a “system for performing a medical examination comprising: means for presenting a series of sensory stimuli for perception by a patient; means for generating electrical signals representing said patient's evoked potentials in response to said sensory stimuli; means

connected to said generating means for detecting said signals; means connected to said detecting means for amplifying said signals; means connected to said amplifying means for recording data representative of said signals; means connected to said recording means for measuring said data; and means connected to said measuring means for *synchronizing the presentation of said series of sensory stimuli with the rate of sampling said evoked potential signals by generating interrupt request signals for initiating and conducting said sampling.*” (Hu, Claim 1, emphasis added)

Claims 2 and 4 of Hu further recite respectively that “said medical examination is a vision examination and ... said means for presenting said series of sensory stimuli comprises a computer operated visual stimulus generating device connected to a display screen for displaying a plurality of patterns for visual observation by a patient” and that “said means for detecting said electrical signals comprises a plurality of electrodes connected to the scalp of a patient and coupled with a visual evoked potential recording and measuring device.”

The claims of Hu fail to teach all of the features of the presently claimed inventive subject matter, as Hu does not claim “*comparing...data to predetermined values to determine if said data is outside of predetermined ranges and thus indicates unreliable data results.*” In fact, the claims of Hu are completely silent as to “unreliable data results.” Moreover, applicants submit that it would not be obvious from the claims of Hu to compare data to predetermined values to determine if the data is faulty data.

Further, Hu claims a feature not claims in the presently claimed inventive subject matter, namely, “*synchronizing the presentation of [a] series of sensory stimuli with the rate of sampling...evoked potential signals by generating interrupt request signals for initiating and conducting...sampling.*” (Hu, Claim 1). Thus, Applicants traverse the Examiner’s statement that “the patented claims are merely an exact and even broader recitation of the claimed pending

subject matter.” (Outstanding Office Action, Paragraph 7) Applicants submit that Hu claims features not claimed in the present application, and that the present application claims features not anticipated or rendered obvious by the claims of Hu.

Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection under the ground of nonstatutory obviousness-type double patenting to claim 42, and to claims 43 and 44 dependent therefrom.

REJECTION UNDER 35 U.S.C. 102(b)

The Examiner rejected claims 42 – 54 under 35 U.S.C. 102(b) as being anticipated by Livingstone.

RESPONSE

Reconsideration and withdrawal of the rejection is requested.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

By this Response and Amendment, Applicants respectfully traverse the Examiner’s rejection since the cited prior art does not disclose, teach or suggest all of the features of independent claim 42.

The presently claimed inventive subject matter as amended recites “a system for performing a medical examination comprising,” *inter alia*, “means connected to...measuring

means for analyzing...data and for *comparing said data to predetermined values to determine if said data is outside of predetermined ranges and thus indicates unreliable data results.*" (Present Application, claim 42, emphasis added).

Livingstone is drawn to a method and apparatus for determining a defective magnocellular pathway in the visual system of a subject. A subject's response to a visually displayed pattern is recorded, and the measured responses are compared to a predetermined range of standard/normal responses for the given displayed pattern, where measured responses falling outside of this predetermined range indicate dyslexia. (Livingstone, Abstract).

Livingstone fails to anticipate the presently claimed inventive subject matter, as it does not disclose, teach, or suggest "comparing said data to predetermined values to determine if said data is outside of predetermined ranges and thus indicates unreliable data results." (Present Application, Claim 42). In Livingstone, data is compared to predetermined values which indicate the presence or absence of a defective magnocellular pathway, and hence dyslexia. Livingstone is completely silent as to comparing measured data to predetermined values to test for "unreliable data results." In contrast to the presently claimed inventive subject matter, data which exceeds Livingstone's "predetermined ranges" is in fact *reliable* data, as it indicates the presence of a defective magnocellular pathway.

Thus, as Livingstone fails to disclose, teach, or suggest all the claimed features of amended claim 42, and thus of claims 43 – 54 dependent therefrom, Livingstone does not anticipate the presently claimed invention. Applicants respectfully request that Examiner reconsider and withdraw the rejections to claims 42 – 54 under 35 U.S.C. 102(b).

Further, the Examiner states that claims 46 – 54 are anticipated by Livingstone. The Examiner specifically asserts that "column 8 lines 31–40" of Livingstone anticipate a computer

program consisting of algorithms for: “determining whether said electrical signals reach a maximum value of the output of said means for amplifying said electrical signals,” “determining and recording if the Fourier component of said electrical signal at 60 Hz exceeds a threshold value via Fourier transform routine,” “determining and recording if said data abruptly jumps beyond predetermined ranges,” “for determining and recording if said electrical signals drift...,” and “determining and recording if the maximum value after segment integration exceeds a threshold value.” (Outstanding Office Action, paragraph 11)

Applicants have conducted an in-depth analysis of Livingstone, and have failed to find evidence of any of these algorithms. Livingstone recites at column 8, lines 31 – 40,

Also a preamplifier may be used in combination with the signal averager 11 (FIG. 1a) as needed. Further, any such preamplification and signal averaging (including synchronization or phase locking to the timing of the stimuli) may be accomplished within computer 7 by hardware, software or a combination thereof. Other combinations or configurations of the functions served by a preamplifier, the signal averager and computer 7 as described above in FIG. 1a are understood by those skilled in the art to be within the scope of the present invention.

Therefore, it can be seen that Livingstone at column 8 lines 31 – 40 nowhere suggests the algorithms recited in claims 46 – 54, and thus does not anticipate the presently claimed invention. For this additional reason, Applicants respectfully request that the Examiner reconsider and withdraw the rejections to claims 46 – 54 under 35 U.S.C. 102(b).

CONCLUSION

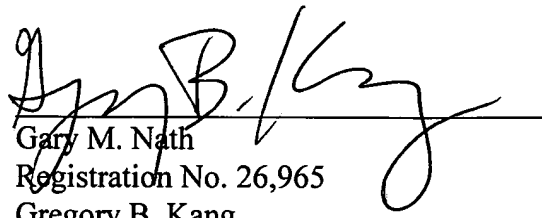
In light of the foregoing, Applicants submit that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,
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